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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
2381Application Number
10/675,145Filed
September 30, 2003First Named Inventor
Jerry OvertonArt Unit
2617Examiner
Nghi H. Ly

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

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This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

- ☒ attorney or agent of record
Registration number 50,967

- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Eric R. Moran

Typed or printed name

312-913-0001

Telephone number

October 12, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

- ☐ *Total of _____ forms are submitted.

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2. Clear Deficiency of Rejections

In order to establish a *prima facie* case of obviousness over a combination of references, the combination must teach or suggest all of the claim limitations. M.P.E.P. § 2143; *In re Royka*, 490 F.2d 981 (CCPA 1974). In this case, the combination of U.S. Patent No. 6,798,385 ("Joyce") and U.S. Patent No. 6,970,548 ("Pines") does not teach or suggest all of the limitations of either independent claim 1 or 12. Accordingly, the combination also fails to teach or suggest all of the limitations of any of dependent claims 2-11 and 13-20.

At a minimum, the combination of Joyce and Pines fails to teach or suggest two elements of Applicant's independent claims: (i) maintaining "a set of data that correlates data-references with . . . device capability information, wherein each data reference points to respective data" and (ii) "querying a set of data to uncover at least one data-reference that the set of data correlates with . . . one or more capabilities of the device." In particular, Applicant's claims include recitations directed to "a set of data" and "querying the set of data." In Applicant's claims, the set of data correlates data-references with location information and with device capability information. Moreover, in Applicant's claims, querying the set of data includes querying to uncover at least one data-reference that the set of data correlates with the current location of the device and with the one or more capabilities of the device. Thus, Applicant's claims recite a data set that correlates data-references with device capability information.

In setting forth the obviousness rejection, the Examiner admitted that "Joyce does not specifically disclose device capability information, determining one or more capabilities of the device, and the data set correlates with the one or more capabilities of the device." Final Office Action, May 18, 2006, p. 3. To make up for the deficiency in Joyce, the Examiner alleged that Pines "teaches device capability information, determining one or more capabilities of the device,

and the data set correlates with the one or more capabilities of the device,” and further asserted that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Pines into the system of Joice.” Office Action, May 18, 2006, p. 3. In addition, in the August 11, 2006, Advisory Action, the Examiner alleged that Pines teaches “querying the set of data to uncover at least one data-reference that the set of data correlates with the one or more capabilities of the device,” and cited the “Pre-announcement field 59” of Pines. Advisory Action, p. 3.

Unlike Applicant’s claimed embodiments, however, Pines does not disclose a set of data that correlates data references with device capability information. Generally, Pines discloses a communication assistance system that comprises a call center that can receive calls from a plurality of callers (e.g., requestors) and route those calls to an operator terminal and a first database. See, e.g., Pines, Abstract. As part of the call routing in Pines, the Pines system “checks the Pre-announcement field 59 of Call Completion Data Packet 50 which indicates whether or not the subscriber of the Wireless Adapter 6 wishes a calling party to be ‘pre-announced.’” Pines, col. 26, lines 14-17. Pines defines the “Call Completion Data Packet 50” as including an origination phone number field, wireless apparatus identification number field, closing prompt code field, and pre-announcement code field. See Pines, Fig. 9; col. 21, lines 4-17. According to Pines, the “pre-announcement” can be a caller’s name and “provides an opportunity to accept or reject the inbound call.” Pines, col. 26, lines 19-20, 40.

In the embodiment of Pines cited by the Examiner, the Pines system “consults the Pre-announcement field 59 of Call Completion Data Packet 50, to determine the method of transmitting the pre-announcement.” Pines, col. 26, lines 31-33. Pines then states that the “pre-announcement can be either in text or voice format” and “[u]sing the fields in Call Completion

Data Packet 50, System 2 determines what format is available based on the carrier and device capabilities of Wireless Adaptor 6." Pines, col. 26, lines 33-37. If the system in Pines determines voice format is available, it then records the caller's name and sends the pre-announcement. Pines, col. 26, lines 31-42.

Thus, even if Pines is taken to teach device capability information and determining one or more capabilities of a device (an assertion that Applicant does not concede), there is no disclosure in Pines of "a set of data that correlates data-references with . . . device capability information, wherein each data reference points to respective data," as claimed by Applicant. More particularly, Pines fails to teach or suggest (i) a set of data; (ii) a data reference pointing to respective data; and (iii) querying a set of data.

First, the set of data recited in Applicant's claims is different than a data packet as disclosed by Pines. A "set of data" as recited by Applicant's claims 1 and 12 correlates data-references pointing to respective data with device capability information. Applicant has included an example of "a set of data" as Figure 8 in Applicant's application. At best, the data packet of Pines may be analogous to one row of the set of data depicted in Applicant's Figure 8 (a point not conceded by Applicant, however). The data packet of Pines does not, however, include a plurality of data references, much less a set of data that correlates the plurality of data references to device capability information, as claimed by Applicant.

Second, it is not clear what the Examiner considers a data reference in the data packet of Pines. As disclosed in Pines, a "pre-announcement" is recorded by a caller after the system has allegedly determined that the receiving device is capable of receiving a pre-announcement in voice format. *See, e.g.*, Pines, col. 26, lines 31-42. Thus, in the data packet of Pines, there is no data reference pointing to respective data, as claimed by Applicant.

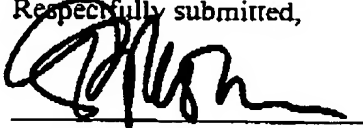
Third, Pines fails to teach or suggest querying a set of data to uncover at least one data-reference. At best, Pines discloses "consulting" a "Pre-announcement field 59" of a "Call Completion Data Packet 50, to determine the method of transmitting the pre-announcement." Pines, col. 26, lines 31-33 (emphasis added). As discussed above, however, a data packet is not a "set of data" as claimed by Applicant, and in the data packet of Pines, there is no data reference pointing to respective data, only information on the method of transmitting. Then, after the system has allegedly determined to transmit the pre-announcement in voice format, the caller records the "pre-announcement." See, e.g., Pines, col. 26, lines 31-42. In any case, "consulting" a single field (the "Pre-announcement field 59"), as disclosed by Pines, is not the same as querying a set of data, as claimed by Applicant.

For all the reasons discussed above, Applicant submits that independent claims 1 and 12 are allowable. Applicant respectfully submits that the Examiner has not established the requisite *prima facie* case of obviousness of Applicant's independent claims 1 and 12, for the reasons discussed above. Because the pending dependent claims 2-11 and 13-20 depend from and include all of the limitations of claims 1 and 12, Applicant respectfully submits that the Examiner has not established the requisite *prima facie* case of obviousness of the pending dependent claims.

3. Conclusion

For the foregoing reasons, Applicant submits that all of the pending claims should be allowed.

Date: 10/12/2006

Respectfully submitted,

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